

## ARGUMENTS

Claims 1 and 30-54 are pending. No claims are allowed.

### Judicially-Created Double Patenting

Claims 1 and 30-54 have been provisionally rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application Serial No. 09/235,159.<sup>1</sup> Submitted herewith is a terminal disclaimer in accordance with 37 CFR 1.321 (b) and (c). Withdrawal of this rejection is respectfully requested.

### The 35 U.S.C. § 103 Rejection

Claims 1 and 30-54 stand rejected under 35 U.S.C. §103 as being allegedly unpatentable over Montenegro.<sup>2 3</sup> This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>4</sup>

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<sup>1</sup> Office Action dated June 19, 2002, ¶ 6.

<sup>2</sup> USP 6,233,688.

<sup>3</sup> Office Action ¶ 8.

<sup>4</sup> M.P.E.P § 2143.

The Examiner states:

The reference of Montenegro fails to explicitly teach of "context barrier for isolating one program module from at least one other". However, it is notoriously well known in the art that "firewall" is used for isolating one program module from another program module, for the reason that client application have access to private resource in a secure manner. Therefore, it would have been obvious for one ordinary skill in the art at the time the invention was made to use an isolating mechanism such as "firewall" as a means for isolating one program module from another program module.<sup>5</sup>

The Applicants submit the Examiner has impermissibly engaged in hindsight construction. The Federal Circuit has repeatedly warned against the use of hindsight construction:

A critical step in analyzing the patentability of claims pursuant to 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."<sup>6</sup>

Additionally, the M.P.E.P. states:

The examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made ... the examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole."<sup>7</sup>

The Examiner's statement that "it *is* notoriously well known in the art that 'firewall' *is used* for isolating one program module from another program module ..." indicates the Examiner failed to step backward in time and into the shoes worn by a

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<sup>5</sup> Office Action ¶ 8.

<sup>6</sup> *In re Kotzab*, 217 F.3d 1369, 55 USPQ2d 1316 (Fed. Cir. 2000) (citations omitted).

person of ordinary skill in the art when the invention was unknown and just before it was made in determining whether the Applicant's invention is rendered obvious under 35 U.S.C. § 103. This is hindsight construction. For this reason, the Applicants submit no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Furthermore, the Examiner has provided insufficient evidence of obviousness.

The Federal Circuit has stated:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.<sup>8</sup>

The Court also advised the Patent and Trademark Office that simply saying that the basis for combining references comes from "common knowledge" or is "common sense" is insufficient:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. ... The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.<sup>9</sup>

Thus, the Examiner's statement that "it is notoriously well known in the art that a 'firewall' is used for isolating one program module from another program module ..." is insufficient evidence of obviousness. For this additional reason, the Applicants submit

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<sup>7</sup> *Id.*

<sup>8</sup> *In re Lee*, - F.3d -, -, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Dependent Claims 30-39, and 49-53

Claims 30-39 and 49-53 depend from claim 1. The base claim being allowable, the dependent claims must also be allowable. Accordingly, the Applicants respectfully request the 35 U.S.C. § 103 rejection with respect to claims 30-39 and 49-53 be withdrawn.

Independent Claims 39, 41-42, 44 and 46-48

Claims 39, 41-42, 44 and 46-48 include limitations similar to claim 1. The arguments made with respect to claim 1 apply equally here. Claim 1 being allowable, claims 39, 41-42, 44 and 46-48 must also be allowable. Accordingly, the Applicants respectfully request the 35 U.S.C. § 103 rejection with respect to claims 39, 41-42, 44 and 46-48 be withdrawn.

Dependent Claims 40, 43, 45 and 54

Claims 40, 43, 45 and 54 depend from independent claims 39, 42, 44 and 39, respectively. The base claims being allowable, the dependent claims must also be allowable. Accordingly, the Applicants respectfully request the 35 U.S.C. § 103 rejection with respect to claims 40, 43, 45 and 54 be withdrawn.

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<sup>9</sup> *Id.* at -, 61 USPQ2d at 1434.

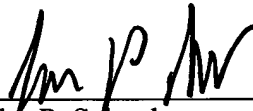
In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,  
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